

REMARKS

Claims 1 to 8 and 10 through 14 now appear in this application. Claim 9 has been canceled and rewritten in independent form, as new Claim 14. Claim 9 was indicated as allowable in the above identified Office Action, if rewritten in independent form. Claim 14 satisfies that requirement and is considered allowable. No additional fees are required for this new independent claim, since the total number of independent claims, including Claim 14, is three.

The cover sheet for the Office Action indicated that Claims 1, 6, 8 and 10 to 13 were rejected and that Claims 2 to 5, 7 and 9 were objected to. In the detailed Office Action, however, Claims 1, 6 and 8 were rejected under 35 U.S.C. §102(b) as anticipated by the United States to Hurlbert No. 2,241,722. Claims 2 to 5, 7, and 10 to 13 then were rejected under 35 U.S.C. §103(a) as unpatentable over the Hurlbert patent. This response considers all but Claim 9 to be rejected as either anticipated or obvious under the Hurlbert patent, and deals with those rejections accordingly.

Before entering into a discussion of the rejections made of the various claims, applicant considers it helpful to briefly outline the structure of the stud construction disclosed in the Hurlbert patent. As mentioned in Lines 17 to 23 of the left-hand column on Page 1 of Hurlbert, it is stated that the invention of Hurlbert contemplates quick and easy means for facilitating the attachment of 3/4" or other narrow gauge metal studs to the floor and ceiling, while at the same time providing a flush nailing base

for the attachment of wood or metal baseboards or trim. In Hurlbert, this is accomplished by attaching what is called ceiling and floor "shoes" or units of greater width than the stud, with the shoes engaging track sections or, alternatively, being attached directly to the floor and ceiling. These attaching shoes are identified as the units A and A¹. Throughout the Hurlbert patent, the studs are referred to as the element B, which in the drawing are the portions which extend between the ceiling unit A¹ and the floor unit A. The studs B of Hurlbert are fitted into holding means C or stud holders C located in the medial portion of the shoes A and A¹. The stud holder may be either in the form of a continuous tubular member, or in the form of transverse straps having a medial loop portion. As mentioned on Page 2, the right-hand column, Lines 6 through 19, the wall finish which is contemplated for the structure of Hurlbert extends flush with the outer faces of the cord members 1-1 (referred to earlier as shoes A and A¹); so that the nailing slot 5 is exposed. The dotted lines W in Figure 2 indicate the outer face of the wall covering. It is apparent from an examination of Figure 2 that the wall covering entirely fills the space between the bottom of the upper shoe unit A¹ and the top edge of the outer surface of the lower shoe unit A. Clearly, no relative vertical movement between the top and bottom shoes is contemplated. If such vertical movement were to take place, stress (perhaps breaking the wall covering W) would take place, since there is no provision for such movement indicated in Hurlbert.

Claims 1,6 and 8 were rejected under 35 U.S.C. §102(b) as
1 being anticipated by the Hurlbert patent No. 2,241,722. It should
2 be noted that in order for a claim to be rejected as anticipated by
3 a reference, such a rejection can be made only if each and every
4 element, as set forth in the claim, is found, either expressly or
5 inherently described in a single prior art reference. This is
6 clearly set forth in MPEP §2131. This section of the MPEP further
7 states that the identical invention must be shown in as complete
8 detail as contained in the claim, and that the elements must be
9 arranged as required by the claim. Applicant respectfully submits
10 that this not true of the Hurlbert patent No. 2,241,722.
11 Consequently, applicant respectfully traverses the rejection of
12 Claims 1,6 and 8 as being improper.

In making a rejection of Claims 1,6 and 8 of this application
13 as anticipated by Hurlbert, the Examiner has redefined the elements
14 of the patent and has taken the position that the shoes A and A¹ of
15 Hurlbert constitute elongated metal studs having a generally U-
16 shaped cross section including a main portion 3, and having first
17 and second side members 2 attached. Even though Hurlbert clearly
18 refers to these elements as shoes or units for attachment to the
19 ceiling and floor, respectively, and the element B as a stud,
20 applicant, for purposes of this current discussion only and for no
21 other purpose, will follow the Examiner's application to the point
22 where it clearly must fail as an anticipatory reference to Claims
23 1,6 and 8.

The Examiner has stated that there is a first receiver

1 attached to the main portion of the "stud" member (A, A¹) and spaced
2 inwardly a predetermined distance from the first and second side
3 members. Such an element is attached to the shoe units of
4 Hurlbert. The Examiner then further stated that Hurlbert shows a
5 clip member (4,D,D¹) having a first portion (4) for attachment to
6 a surface located above the "stud" (A,A¹) and having a first
7 elongated "stabilizing bar" (B) attached thereto and extending
8 downwardly to slidably engage the first receiver on the stud member
9 (A,A¹). Applicant respectfully submits that even if the stud B of
10 Hurlbert is called a stabilizing bar, it is not attached to and
11 extending downwardly from the clip member 4,D,D¹). On the
12 contrary, the shoes A and A¹ are attached to the clip members; and
13 there is no attachment of the stud B to the clip member to engage
14 the receiver (C) on the shoes (A,A¹). The elements arranged as
15 required by Claims 1,6 and 8 are not present in Hurlbert. The rejection
16 of Claims 1,6 and 8 under 35 U.S.C. §102(b) is improper and should
17 be withdrawn.

18 Claims 2 to 5, 7 and 10 to 13 were rejected under 35 U.S.C.
19 §103(a) as being unpatentable over the Hurlbert patent No.
20 2,241,722. In support of this rejection, the Examiner stated that,
21 regarding Claims 2 to 5, 7, Hurlbert shows metal, and that it would
22 be an obvious design choice to have two elongated stabilizing bars
23 and two hollow channels to increase the strength of the connection
24 between the stabilizing bars and stud. It should be noted that the
25 Examiner's analysis of the structure of the Hurlbert patent, as

provided in conjunction with the §102(b) rejection, functions essentially as a reconstruction of the Hurlbert patent by calling the stud B of Hurlbert a stabilizing bar and by calling the shoes A and A¹ studs. Even if this construction were to be considered as an appropriate reconstruction of Hurlbert, it should be noted that the stabilizing bar (actually, the stud B) does nothing whatsoever, in Hurlbert, to hold the stud (shoes or holders A and A¹) in position. The shoes A and A¹ are connected to the tracks D and D¹ by means of interlocking members 4. The stud B, called a stabilizer bar by the Examiner, does not operate in any manner to hold the units A and A¹ in place. Those units hold the stud B in place. The Examiner is attempting a reconstruction of Hurlbert to arrive at the claimed invention which only can be based on applicant's own disclosure. There is no teaching, motivation or suggestion whatsoever in Hurlbert of modifying the disclosure of Hurlbert in such a manner to rearrange the parts and the function of those parts to provide a basis for rejecting applicant's claims. Consequently, applicant respectfully submits that it is well established that even if all of the elements are disclosed in various prior art references or in a single prior art reference, the claimed invention, taken as a whole, cannot be said to be obvious without some reason given in the prior art as to why one of ordinary skill would have been prompted to modify the teachings of the reference to arrive at the claimed invention. As noted in MPEP §2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless

the prior art also suggests the desirability of the combination (or modification).

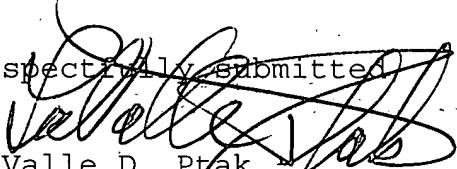
Applicant respectfully submits that in order to reject Claims 2 to 5, 7 and 10 to 13 as unpatentable over Hurlbert under 35 U.S.C. §103(a), it is necessary to so drastically modify the Hurlbert patent and the manner in which it functions, that the operation of the Hulbert device is destroyed. Hurlbert is directed to a different invention, for a different purpose, than the invention of the claims of this application. Consequently, withdrawal of the rejection of Claims 2 to 5, 7 (and Claims 10 to 13 for the reasons outlined below) is respectfully requested.

Claim 10 is an independent method claim; and Claims 11 to 13 are dependent, either directly or through one another, on Claim 10. Hurlbert does not have a clip member which operates in conjunction with the stud; so that a stabilizing bar holds the stud in position. The Examiner has taken the position that the stud B of Hurlbert is a stabilizing bar. When this is done, it is quite apparent from an examination of Hurlbert, that the element B of Hurlbert does not hold the other parts, whatever they may be called, in position. These parts are separately positioned and attached to the floor and ceiling; and the element B then is extended between them. The element B does not operate to locate any other members; and it does not hold the stud (elements A, A¹ in the Examiner's definition) in position. Applicant respectfully submits that the tortuous re-definition of the various elements of the Hurlbert patent to read this patent on applicant's claims fails

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entirely, even if it is to be considered acceptable (and applicant
respectfully submits that this re-definition of terms is not
acceptable), since the method which is clearly recited in
independent Claim 10 and dependent Claims 11 through 13 is not
present, either in Hurlbert as defined by Hurlbert himself, or in
the reconstructed Hurlbert made by the Examiner.

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In view of the foregoing, applicant respectfully requests
reconsideration and withdrawal of the rejection of Claims 1 to 8
and 10 to 13. Allowance of all of these claims, along with Claim
14 (Claim 9 rewritten in independent form), is respectfully
requested; and a formal Notice of Allowance of the application is
respectfully solicited.

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Respectfully submitted,

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